

Applicants' components (C), (D), and (E).

Tipton et al relates to polymeric compositions, oil compositions containing said polymeric compositions, transmission fluids and hydraulic fluids. The polymer compositions comprise (A) at least one polymer which is a homopolymer of a non-aromatic monoolefin, or a copolymer of said non-aromatic monoolefin with an aromatic monoolefin, and (B) (1) a nitrogen-containing ester of a carboxy-containing interpolymers and/or (2) an acrylate polymerization product of an acrylic ester or a mixture of (1) and (2). The compositions also include a viscosity-reducing liquid organic diluent, such as a naphthenic oil or an alkylated aromatic material. Tipton et al teaches that the transmission fluids and hydraulic fluids containing this combination of additives has good high and low viscosity as well as shear stability.

Tipton et al does not define shear stability by any given test. Shear stability may be determined by a number of different tests which have different degrees of test severity. Applicants' claims are directed to lubricating compositions which provide a specific value in one of the most severe shear stability test, namely the taper bearing test. Tipton et al contains no disclosure to the degree of shear stability of the lubricating compositions. Further, there is no teaching in Tipton et al which would lead a skilled person to the specific combination of additive required by Applicants';s claims. Applicants have discovered a balance of additives which provide good shear stability in the most severe test and also provide good high and low temperature viscosimetrics.

Tipton et al does not teach or suggest the levels of the additives in Applicants' claims. The Examples of Tipton et al fail to provide the required levels of polymer (A). Tipton et al Examples B and C are automatic transmission fluids. Tipton et al contains no teaching to the base fluids used in preparing the formulation. Applicants claims require that the oil of lubricating viscosity has a specific viscosity, e. g. less than about 8 cSt at 100°C. This type of oil of lubricating viscosity is thinner than most oils used in lubricants, such as gear oils. To provide the proper viscosimetrics, more polymer is needed. The higher level of polymer adversely affects the low temperature properties and the shear stability or the lubricating composition. Tipton et al Examples D-F use a lower viscosity oil (100 N mineral oil) but the level of polyisobutylene is much lower (4.24, 6.52, and 4.89) than the required

amounts of Applicants' claims (from about 15% to about 40% by weight). Tipton et al fails to teach or suggest an additive combination which can provide the proper viscosity using a lower viscosity oil of lubricating viscosity, e.g. less than about 8 cSt.

Since Tipton et al fails to provide guidance to a skilled person which would motivate them to alter the lubricants of Tipton et al to make the lubricating compositions of Applicants' claims, Applicants submit that Tipton et al does not render obvious their claims. Applicants request withdrawal of the rejection and allowance of the claims.

Claim 12 stand rejected under 35 U.S.C. § 112, fourth paragraph as being in improper dependent form for failing to further limit the subject matter of a previous claim. The rejection states that it is not clear how gear oil in claim 12 limits claim 1.

Claim 12 requires that the lubricating composition is a gear oil. Claim 1 may be any lubricating composition which meets the claims limitations. The lubricating compositions may include a gear oil but also would include other oils. Claims 12 further limits claim 1 by restricting the lubricating composition to those which are useful in lubricating gears. Therefore, Applicants submit that claim 12 further limits claim 1 and request withdrawal of this rejection.

In the event any issues remain in the prosecution of this application, Applicants request the Examiner call the undersigned attorney to expedite allowance of the claims. If any fees are required for the filing of these papers, Applicants request the Commissioner to charge those fees to deposit account #12-2275.

Respectfully submitted,

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